



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

11601 RIVER MARK CENTER
SUITE 888-A
IRVINE, CA 92618-1334

EXAMINER

LAWRENCE, 2

ART UNIT

PAPER NUMBER

DATE MAILED:

04/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/317,303	DONOHO, BRUCE A.
Examiner	Art Unit	
Jack W Lavinder	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) Responsive to communication(s) filed on 02 March 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 3-6,8 and 9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 3-6, 8, 9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:

1. received.

2. received in Application No. (Series Code / Serial Number) _____.

3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) Notice of References Cited (PTO-892)
 15) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 16) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

17) Interview Summary (PTO-413) Paper No(s). _____
 18) Notice of Informal Patent Application (PTO-152)
 19) Other: _____

Claims

Claims 1, 2, and 7 have been cancelled.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3-2-00 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a notch (19) on the rail (15) of the device. The specification states, on page 8, "A notch (19) provides a convenient cutting line at various locations along the *base member 12* to permit ..." (emphasis added). In order to overcome this objection, new drawings are required to show the notch on the base member (12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, 3,282,000 in view of Negre, 5,400,552.

Shaw, '000 discloses making a bird repellent structure from injection molded plastic (i.e. the pieces which make up the structure can be made from plastic (column 3, lines 55-60). Shaw fails to disclose making the structure in the form of an injection-

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ca molded unitary structure. The examiner notes that injection-molding a product that was once made from separate parts is notoriously old and well known. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the bird repelling device of Shaw, '000 by injection-molding the device in a single unitary mold because the courts have noted that making something separable into something integral is well within the level of someone having ordinary skill in the art. In re Larson et. al., 144 USPQ 347.

cs Shaw, '000 discloses a glue trough (i.e. in figure 4, the space under the reference numeral 24' is considered to be a trough capable of receiving glue) but fails to explicitly disclose using glue to attach the device. Negre discloses that it is old and well known to use glue (7, figure 4) to attach a bird repelling device to a support structure. Therefore, it would have been obvious to use glue, as taught by Negre, to attach the bird repelling device in Shaw, '000 to a support surface. This will prevent the repelling device from falling from the support surface during high winds.

ct Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, '000 in view of Negre, as applied to claim 9, and in further view of Donoho, 5,253,444. Shaw discloses prongs having a square cross sectional shape. The claim recites prongs having a circular cross sectional shape. Donoho discloses that it is old and well known to make the prongs with a circular cross sectional shape wherein the end is in the form of a conical point (figure 3, column 3, lines 35 and 36). Therefore, it would have been an obvious design choice to make the prongs have a circular cross sectional shape since the specification fails to state solving any particular problem by using a

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circular cross sectional shape and it appears that either shape works equally as well as the other in repelling birds.

Response to Arguments

Applicant's arguments with respect to claims 3-6, 8, and 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W Lavinder whose telephone number is 703-308-3421. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703-308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-0285 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.



Jack W Lavinder
Primary Examiner
Art Unit 3644

4/14/00